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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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*Ex parte* AL J. MOONEY

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Appeal 2008-2550
Application 09/492,398
Technology Center 2100

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Decided: January 13, 2009

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Before ALLEN R. MACDONALD, JAY P. LUCAS, and
STEPHEN C. SIU, *Administrative Patent Judges*.

SIU, *Administrative Patent Judge*.

## DECISION ON APPEAL

## STATEMENT OF THE CASE

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 50-67. Claims 1-49 have been cancelled and claims 68-71 have been withdrawn. We have jurisdiction under 35 U.S.C. § 6(b). We affirm-in-part and enter a new ground of rejection under 35 U.S.C. § 101, against claims 50-67.

*The Invention*

The disclosed invention relates generally to delivering medical supplies (Spec. 1). Specifically, a medical care provider lists medical supplies that the provider may prescribe to patients (*id.* 2). The patient selects the prescribed supply and submits a payment for the supply to a vendor (*id.* 2-3) and the supply is shipped to the patient (*id.* 3).

Independent claim 50 is illustrative:

> 50. A method of prescribing and selling a medical supply through a website associated with a medical care provider comprising:
>
> conducting a medical examination on a patient, wherein the medical examination is conducted by the medical care provider;
>
> prescribing the medical supply for the patient, wherein the medical supply is prescribed by the medical care provider based on the results of the medical examination;
>
> accessing the website associated with the medical care provider, wherein the website includes an array of prescription medical supplies including the medical supply prescribed by the medical care provider;
>
> ordering the medical supply prescribed by the medical care provider from the website associated with the medical care provider; and
>
> wherein the medical care provider that prescribed the medical supply receives payment for the medical supply ordered from the website associated with the medical care provider.

*The Reference*

The Examiner relies upon the following reference as evidence in support of the rejection:

| | | |
|---|---|---|
| Silver | US 6,269,339 B1 | Jul. 31, 2001 (filed Dec. 29, 1998) |

*The Rejection*

The Examiner rejects claims 50-67 under 35 U.S.C. § 102(e) as being anticipated by Silver.

ISSUE #1

Appellant asserts that "a medical examination is 'an appropriate consultation' in which the medical care provider conducting the medical examination makes an informed medical judgment based on the circumstances of the situation, and on his or her training and experience" (Revised App. Br. 7). Appellant further asserts that Silver discloses a "questionnaire [that] includes a number of various common queries designed to elicit general information about a user's personal habits and demographics, which are used for marketing" (*id.*) which, according to Appellant, does not constitute a "medical examination" as recited.

The Examiner finds that "completing the questionnaire of Silver achieves one manner of examination" (Ans. 7).

Did Appellant demonstrate that the Examiner erred in finding that Silver discloses a medical examination?

FINDINGS OF FACT

The following Findings of Facts (FF) are shown by a preponderance of the evidence.

1. Silver discloses a system and method for providing a user with "personalized wellness options" (Abstract) via an interface to a program conducted by a physician such as Dr. Michael Roizen, Chairman, Dept. of Anesthesia & Critical Care (Figure 2).
2. Silver discloses that a medical system prompts a user for answers to questions pertaining to a "health profile questionnaire" (col. 9, ll. 25-26) that is "used to assess a user's relative wellness" (col. 9, ll. 42-43).
3. Silver further discloses that, based on the patient history, the system determines "recommendations for a given user based upon physiological age graphs" (col. 17, ll. 30-31). As one example, the medical care provider may recommend "taking 250 mg of vitamin C three times per day" (col. 17, ll. 46-47).
4. Silver discloses providing "commercial sources of vitamin C" (col. 17, l. 48), for example, via "a product database 2506" (col. 17, l. 57).
5. Silver discloses that a user is presented via an interface managed by a medical care provider (i.e., Dr. Michael Roizen) with "information on products that can be purchased . . . which directly affect the factor in question" (col. 17, ll. 43-44).
6. Silver also discloses that the interface provides the user or patient with a "summary of the products that are associated with the selected

recommendations" (col. 18, ll. 56-58) along with "a further report . . . listing the contact information for those merchants that sell products and services to assist the user in the recommendations that are selected" (col. 18, ll. 58-61).

7. The term "device" includes anything that is "a piece of equipment or a mechanism designed to serve a special purpose or perform a special function" (*Merriam-Webster's Collegiate Dictionary* (11th ed., 2005)).
8. Silver discloses that the "products could be endorsed by the system manager of the present invention for a fee, which fee would be paid to the operator of the present invention" (col. 19, ll. 2-4).

## PRINCIPLES OF LAW

### *35 U.S.C. § 101*

"A claimed process is . . . patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing." *In re Bilski*, 545 F.3d 943, 954 (Fed. Cir. 2008). However, "even if a claim recites a specific machine or a particular transformation of a specific article, the recited machine or transformation must not constitute mere 'insignificant postsolution activity'." *Id.* at 957.

### *35 U.S.C. § 102*

In rejecting claims under 35 U.S.C. § 102, "[a] single prior art reference that discloses, either expressly or inherently, each limitation of a

claim invalidates that claim by anticipation." *Perricone v. Medicis Pharm. Corp.,* 432 F.3d 1368, 1375 (Fed. Cir. 2005) (citation omitted). "Anticipation of a patent claim requires a finding that the claim at issue 'reads on' a prior art reference." *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346 (Fed Cir. 1999) "In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art." (*Id.*) (internal citations omitted).

ANALYSIS (ISSUE #1)

Silver discloses a system and method for providing a user with "personalized wellness options" (Abstract) via an interface to a program conducted by a physician such as Dr. Michael Roizen, Chairman, Dept. of Anesthesia & Critical Care (Figure 2). Silver's medical system prompts a user for answers to questions pertaining to a "health profile questionnaire" (col. 9, ll. 25-26) that is "used to assess a user's relative wellness" (col. 9, ll. 42-43). Hence, Silver discloses a physician (e.g., Dr. Michael Roizen) conducting a series of inquiries with a patient to obtain a medical history, which we find to be equivalent to a medical care provider conducting a medical examination.

Appellant argues that "[m]edical examinations include physical examinations and tests, and are performed by licensed medical care providers" (Revised App. Br. 7). A medical examination, construed broadly

but reasonably, includes any investigation or inquiry into medical-related issues of a patient. While we agree with Appellant that a medical examination may include any of a history, a physical examination, or a diagnostic test, we disagree that a medical examination must include each of a history, a physical examination, and at least one diagnostic test. Indeed, taking a history from a patient entails examining the patient over medical-related issues. In our view, this constitutes a "medical examination."

For at least the aforementioned reasons, we conclude that Appellant has not sustained the requisite burden on appeal in providing arguments or evidence persuasive of error in the Examiner's rejection of claim 50-67 with respect to issue #1.

ISSUE #2

Appellant asserts that "Silver simply fails to disclose a doctor conducting a medical examination as recited in claim 50" (Revised App. Br. 9) because, while Silver discloses "an *automated* computerized questionnaire" (Revised App. Br. 8), "the doctor in Silver never poses the questions to the patient. Instead, the computer does" (*id.*). Appellant further asserts that Silver discloses an "automated computerized questionnaire [that] simply does not fall within the realm of a medical care provider" (*id.* 9).

Did Appellant demonstrate that the Examiner erred in finding that Silver discloses a medical care provider conducting a medical examination?

ANALYSIS (ISSUE #2)

As set forth above, we agree with the Examiner that Silver discloses a medical care provider (i.e., Dr. Michael Roizen – Figure 2) who conducts a medical examination (i.e., poses questions to a patient to elicit a medical history).

Appellant argues that "the doctor in Silver never poses the questions to the patient. Instead, the computer does" (Revised App. Br. 8). However, while the medical care provider (i.e., Dr. Michael Roizen) may utilize a computer to assist in obtaining a medical history from a patient, we agree with the Examiner that the medical care provider is nevertheless conducting the examination. Because the medical care provider (Dr. Michael Roizen in this example) oversees the system and provides the questions to elicit the patient history in the first place, we find that the medical care provider is conducting the examination using the computer as a tool to assist in the administration of the examination rather than the computer itself conducting the examination independently of any actions taken by the medical care provider.

For at least the aforementioned reasons, we conclude that Appellant has not sustained the requisite burden on appeal in providing arguments or evidence persuasive of error in the Examiner's rejection of claim 50-67 with respect to issue #2.

ISSUE #3

Appellant asserts that Silver discloses "recommendations . . . [that] are no more than 'common sense' suggestions" (Revised App. Br. 11) but fails to disclose prescribing a medical supply for a patient because the "recommendations [of Silver] do not 'designate or order the use of as a remedy'" (Revised App. Br. 10).

Did Appellant demonstrate that the Examiner erred in finding that Silver discloses prescribing a medical supply for a patient?

ANALYSIS (ISSUE #3)

As set forth above, Silver discloses a medical care provider conducting a medical examination of a patient to obtain a patient history. Silver further discloses that, based on the patient history, the system determines "recommendations for a given user based upon physiological age graphs" (col. 17, ll. 30-31). As one example, the medical care provider may recommend "taking 250 mg of vitamin C three times per day" (col. 17, ll. 46-47). Thus, Silver discloses a medical care provider determining a course of treatment for a patient based on a medical examination of the patient and recommending or "prescribing" the course of action to the patient (e.g., taking vitamin C). We find no distinction between the disclosure of Silver and the claimed feature of a medical care provider prescribing a medical supply for a patient.

Appellant argues that the "recommendations [of Silver] do not 'designate or order the use of as a remedy'" (Revised App. Br. 10). We

disagree. Silver discloses a physician determining, for example, a vitamin C deficiency in a patient based on the results of a medical examination and designating the use of a vitamin C supplement as a "remedy." Appellant has not demonstrated specific differences, nor do we find any specific differences, between Silver's disclosure and the claimed feature of prescribing a medical supply for a patient.

For at least the aforementioned reasons, we conclude that Appellant has not sustained the requisite burden on appeal in providing arguments or evidence persuasive of error in the Examiner's rejection of claims 50-67 with respect to issue #3.

ISSUE #4

Appellant asserts that while Silver discloses that "a fee . . . is paid to a system operator" (Revised App. Br. 12), "there is no indication in the patent to Silver as to who the system managers and operators are" (*id.*). Therefore, Appellant argues that Silver fails to disclose that the medical care provider receives payment for the medical supply ordered from the website.

Did Appellant demonstrate that the Examiner erred in finding that Silver discloses a medical care provider receiving payment of a medical supply ordered from a website?

ANALYSIS (ISSUE #4)

As set forth above, Silver discloses a system operated by a medical care provider (e.g., Dr. Michael Roizen) that recommends or "prescribes" a

course of action (e.g., taking vitamin C supplements). Silver also discloses providing "commercial sources of vitamin C" (col. 17, l. 48), for example, via "a product database 2506" (col. 17, l. 57). Also in this example of Silver, Dr. Michael Roizen, as the entity who endorsed the recommended products (e.g., vitamin C "could be endorsed by the system manager" – col. 19, l. 2), may receive a fee, "which fee would be paid to the operator of the present invention" (col. 19, ll. 3-4). Hence, Silver discloses a medical care provider who operates a system for recommending a health-related course of action for a patient based on the results of a medical history and receiving a fee based on patient selection of products endorsed by the medical care provider. We find no distinction between Silver's disclosure and the claimed feature of a medical care provider receiving payment for a medical supply ordered from the website.

Appellant argues that "there is no indication in the patent to Silver as to who the system managers and operators are" (Revised App. Br. 12). However, Silver discloses that Dr. Michael Roizen (Figure 2), who is a health care provider, operates the system. Therefore, we agree with the Examiner that the "system manager" and "system operator" includes the medical care provider (i.e., Dr. Michael Roizen).

For at least the aforementioned reasons, we conclude that Appellant has not sustained the requisite burden on appeal in providing arguments or evidence persuasive of error in the Examiner's rejection of claims 50-67 with respect to issue #4.

ISSUE #5

Appellant asserts that Silver fails to disclose that "the medical care provider . . . not only conducts the medical examination and prescribes the medical supply, but also receives the order from the user for the prescribed medical supply" (Revised App. Br. 19).

Did Appellant demonstrate that the Examiner erred in finding that Silver discloses that the medical care provider that prescribed the medical supply receives an order through the website for the medical supply?

ANALYSIS (ISSUE #5)

Silver discloses that a user is presented via an interface managed by a medical care provider (i.e., Dr. Michael Roizen) with "information on products that can be purchased . . . which directly affect the factor in question" (col. 17, ll. 43-44). Silver also discloses that the interface provides the user or patient with a "summary of the products that are associated with the selected recommendations" (col. 18, ll. 56-58) along with "a further report . . . listing the contact information for those merchants that sell products and services to assist the user in the recommendations that are selected" (col. 18, ll. 58-61). Therefore, Silver discloses that the medical care provider provides health-related recommendations to a patient, a list of products for the patient's use, and a list of merchants that sell the products.

While we agree with the Examiner that Silver discloses that a medical provider (e.g., Dr. Michael Roizen) conducts a medical examination on a patient and prescribes a medical supply to the patient, the Examiner has not

demonstrated that the medical care provider that prescribed the medical supply receives an order for the medical supply. Rather, Silver discloses that the patient orders the product recommended by the medical care provider via a merchant. The Examiner has not demonstrated that the merchant is also the medical care provider (i.e., Dr. Michael Roizen).

Accordingly, we conclude that Appellant has met the burden of showing that the Examiner erred in rejecting claims 62-67 with respect to issue #5.

ISSUE #6

Appellant asserts that "none of the recommendations [of Silver] appear to be anything that would require or suggest that the user purchase a 'medical device'" (Revised App. Br. 14). Thus, Appellant argues that Silver fails to disclose a supplier of medical devices.

The Examiner finds that "vitamins or packages of vitamins would be readable as the claimed medical devices, since they are therapeutic in nature and intended as a medical treatment for a defined problem" (Ans. 8).

Did Appellant demonstrate that the Examiner erred in finding that Silver discloses a supplier of medical devices?

ANALYSIS (ISSUE #6)

Construing the term "medical device" broadly but reasonably, we find that a medical device includes any piece of equipment designed to serve a health-related purpose. While vitamins may be considered a form of

pharmaceutical regimen, we disagree with the Examiner that vitamins constitute a "piece of equipment." Nor does the Examiner demonstrate that Silver discloses a supplier of any health-related pieces of equipment or devices.

Accordingly, we conclude that Appellant has met the burden of showing that the Examiner erred in rejecting claim 52 with respect to issue #6.

ISSUE #7

Appellant asserts that Silver discloses "that a system manager . . . could endorse the products for a fee – a fee that is paid to a *separate* system operator" (Revised App. Br. 15) but that "there is no indication in Silver as to whom these entities represent" (*id.*). Hence, Appellant argues that Silver fails to disclose that "these entities represent *both* the medical care provider and the medical supply vendor, and further, that they are one in the same entity" (*id.*).

Did Appellant demonstrate that the Examiner erred in finding that Silver discloses that the medical supply vendor is the medical care provider?

ANALYSIS (ISSUE #7)

As set forth above, Silver discloses a medical care provider (e.g., Dr. Michael Roizen) conducting a medical examination, providing recommendations for health care products based on the medical examination, and providing a "report to the user listing the contact

information for those merchants that sell products . . . to assist the user in the recommendations that are selected" (col. 18, ll. 58-61). We agree that any of the merchants listed on the report may constitute a "medical supply vendor." However, the Examiner has not demonstrated that any of the "merchants that sell products" or medical supply vendors listed on the report provided by the medical care provider is the medical care provider.

Accordingly, we conclude that Appellant has met the burden of showing that the Examiner erred in rejecting claim 54 with respect to issue #7.

ISSUE #8

Appellant asserts that "Silver fails to disclose that an e-commerce provider credits or debits the account of the medical supply vendor for the sale of the prescribed medical supply or device, wherein the e-commerce provider and the medical care provider are the same entity" (Revised App. Br. 16).

Did Appellant demonstrate that the Examiner erred in finding that Silver discloses that the e-commerce provider is the medical care provider?

ANALYSIS (ISSUE #8)

As set forth above, Silver discloses a medical care provider operating a medical care interface through which the medical care provider conducts a medical examination and provides recommendations and product information to patients based on the medical examination. Silver also

discloses that the "products could be endorsed by the system manager of the present invention for a fee, which fee would be paid to the operator of the present invention" (col. 19, ll. 2-4). Hence, Silver discloses that the medical care provider (e.g., Dr. Michael Roizen), who operates and manages an interface and who is therefore a "system manager," endorses a product and receives a fee for endorsing the product from the vendor of the product. We agree with the Examiner that if a medical care provider manages and operates a system that collects a fee from a product vendor, the medical care provider, by collecting the fee, debits the account of the product vendor and credits the account of the medical care provider.

Appellant argues that "[t]here is no indication as to who these entities [system manager and system operator] represent, and certainly no indication of who pays these entities" (Revised App. Br. 17). However, the medical care provider (i.e., Dr. Michael Roizen) of Silver manages and operates the system and therefore constitutes a "system manager" or a "system operator." Also, because Silver discloses that a fee is paid to the operator because the operator endorses a product, we agree with the Examiner that it is clear that the fee, being paid in exchange for endorsing the product, is paid by an entity that manufactures or sells that product.

For at least the aforementioned reasons, we conclude that Appellant has not sustained the requisite burden on appeal in providing arguments or evidence persuasive of error in the Examiner's rejection of claim 57 with respect to issue #8.

ISSUE #9

Appellant asserts that "Silver does not disclose that an e-commerce provider credit or debit the account of the medical care provider" (Revised App. Br. 18).

Did Appellant demonstrate that the Examiner erred in finding that Silver discloses a provider that credits or debits an account associated with the medical supply vendor and an account associated with the medical care provider?

ANALYSIS (ISSUE #9)

We agree with the Examiner that Silver discloses an e-commerce provider who credits or debits an account of a medical supply vendor and an account of a medical care provider for reasons set forth above.

Therefore, we conclude that Appellant has not sustained the requisite burden on appeal in providing arguments or evidence persuasive of error in the Examiner's rejection of claim 60 with respect to issue #9.

NEW GROUND OF REJECTION -- 37 C.F.R. § 41.50(b)

We reject claims 50-67 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

The Court of Appeals for the Federal Circuit recently held that "the applicable test to determine whether a claim is drawn to a patent-eligible process under §101 is the machine-or-transformation test set forth by the Supreme Court and clarified herein . . . ." *In re Bilski*, 545 F.3d at 966.

Appellant's claims 50-67 do not transform physical subject matter. To the extent that Appellant's claims may transform data, we note that transformation of data, without a particular machine, is insufficient to establish patent-eligibility under § 101. *See In re Bilski*, at 961 ("[E]ven a claim that recites 'physical steps' but neither recites a particular machine or apparatus, nor transforms any article into a different state or thing, is not drawn to patent-eligible subject matter.").

We conclude that Appellant's claimed invention does not require a particular machine or apparatus, nor do these claims transform any article into a different state or thing and is therefore not directed to statutory subject matter under 35 U.S.C. § 101.

## CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that Appellant has failed to demonstrate that the Examiner erred in finding that:

1. Silver discloses a medical examination (issue #1),

2. Silver discloses a medical care provider conducting a medical examination (issue #2),

3. Silver discloses prescribing a medical supply for a patient (issue #3),

4. Silver discloses a medical care provider receiving payment of a medical supply ordered from a website (issue #4),

5. Silver discloses that the e-commerce provider is the medical care provider (issue #8),

6. Silver discloses a provider that credits or debits an account associated with the medical supply vendor and an account associated with the medical care provider (issue #9),

However, Appellant has demonstrated that the Examiner erred in finding that Silver discloses that the medical care provider that prescribed the medical supply receives an order through the website for the medical supply (issue #5), that Silver discloses a supplier of medical devices (issue #6), and that Silver discloses that the medical supply vendor is the medical care provider (issue #7).

## DECISION

We affirm the Examiner's decision rejecting claims 50, 51, 53, 55-61 under 35 U.S.C. § 102(e). We reverse the Examiner's decision rejecting claims 52, 54, and 62-67 under 35 U.S.C. § 102(e).

In a new ground of rejection, we have rejected claims 50-67 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

In addition to reversing the Examiner's rejection(s) of one or more claims, this decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides that "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

> (1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .
>
> (2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED-IN-PART
37 C.F.R. § 41.50(b)

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